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10/046,997	01/16/2002	Michael Wayne Brown	AUS920010746US1	6351
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EXAMINER				
BARTLEY, KENNETH				
ART UNIT		PAPER NUMBER		
3693				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/046,997

Applicant(s)

BROWN ET AL.

Examiner

KENNETH L. BARTLEY

Art Unit

3693

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 7, 2008 has been entered.

Response to Amendment

2. Claims 1-3, 8-10, and 14-16 have been amended. Claims 7 and 20 have been canceled. Claims 1-6 and 8-19 are pending in the application and are provided to be examined upon their merits.

Response to Arguments

3. Applicant's arguments with respect to claims 1-6 and 8-19 have been considered but are moot in view of the new ground(s) of rejection. The Examiner, however, provides a response in **bold** below where appropriate.

Applicant argues 35 U.S.C. § 112, 1st para. rejection beginning on page 7:
The Examiner rejected claims 1-20 because the claims recited authorizing a request when a location of a mobile device was different from the location of a vendor. The Applicant has amended their claims to overcome this rejection:

Art Unit: 3693

Applicant has amended claims 1, 8 and 14, and demonstrated in this document support for the amendments. Therefore, the objection of the specification under 35 U.S.C. §112, first paragraph has been overcome.

In reviewing the amended claims, the Examiner removes the 35 U.S.C. §112, first paragraph rejection.

Applicant argues 35 U.S.C. § 103 rejection for claims 1-20 beginning on page 8:

Applicant cites prior art:

The Examiner has rejected claims 1-20 under 35 U.S.C. § 103 as being unpatentable over Suzuki (U.S. Patent Number 6,612,488) (hereinafter "Suzuki") in view of Joao et al. (U.S. Publication Number 2001/0051920) (hereinafter "Joao"). This rejection is respectfully traversed.

The Examiner notes that because of the amendments, the claims are rejected on new grounds presented below.

Claim Rejections - 35 USC § 112

4. Claims 1-6 and 8-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. Claim 1 teaches a second user making a transaction over a phone or internet, and changing a second communication device to a location of a vendor supplying goods or services over the phone or the internet. However, Applicant's specification teaches changing the location to that of the account holder, not that of the vendor location. Specifically,

"In the case where the account holder is purchasing goods or services with a vendor over the phone or via the Internet, the merchant location information can be changed to the location of the account holder, such that the two locations will match."

Claims 8 and 14 have similar issues. Claims 2-6, 9-13, and 15-19 are rejected because they depend from their respective independent claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3693

8. Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,612,488 to Suzuki in view of U.S. Patent No. 6,941,129 to Marcè et al and in further view of U.S. Patent No. 6,515,595 to Obradovich et al.

[Note that the analysis for the method claims (1-3, 5-6, 4,) also applies to the respective system claims (8-10, 12-13, 11) and product claims (14-16, 17-18). There is no product claim that matches to claims 4 and 11]

Regarding claims 1, 8 and 14:

(claim 1) A computer implemented method for authorizing transactions against an account comprising:
associating a first communication device identification with a first communication device, wherein the communication device identification is associated with a cardholder, and further wherein the cardholder is a first user;

Suzuki teaches:

Fig. 5, which has a communication device (cell phone) with a device id (cell phone number 090-890-1818), associated with a cardholder (Taro Yamada).

associating a second communication device identification with a second communication device, wherein the second communication device is associated with a second user different from the cardholder;

Fig. 5 has a second communication device (cell phone) with a device id (cell phone number 090-794-06749), associated with a second cardholder (Hanako Suzuki)

receiving a transaction comprising a request for authorization to charge an amount against the account using a card associated with the cardholder;

Fig. 7 teaches using a "Transaction Authorization Computer" for receiving card information for charges made by a card associated with a cardholder.

receiving a request to change the first communication device identification to the second communication device identification corresponding to the second communication device;

Suzuki teaches replacing identity-related verification information on a portable device:

"Also, the cellular phone used in the aforementioned embodiments may be a digital cellular phone using the PDC (Personal Digital Cellular) system, GSM (Global System for Mobile Communication) system, or CDMA (Code Division Multiple Access), or it may be a simple cellular phone on the PHS (Personal Handyphone System) system, but is not limited to these, and may also be another type of portable communication terminal. Moreover, identity-related verification information such as the telephone number of the

Art Unit: 3693

portable communication terminal may be stored in removable semiconductor memory in the portable communication terminal and one may replace the semiconductor memory and use the portable communication terminal for its original use.” (col. 14, lines 32-45)

(see below under Transfer)

in response to the second user making a transaction with the card over the phone or on an internet website, transmitting a unique code entered by the cardholder to a central computer to authorize changing a second location to match the location of the second communication device, wherein the second location is a location of a vendor supplying goods or services over the phone or the internet website; and

(see below Change location)

authorizing the transaction when the unique code is received.

(see below Change location)

Transfer

Suzuki discloses two communication devices, where ID verification that may be removed from the communication devices.

Suzuki does not disclose transferring the ID verification to a second device.

Marcè et al. discloses mobile communication devices:

“Thereeto, the telecommunication system according to the invention is characterised in that said database comprises subscriber-information related to said identification code for allowing at least a part of said subscriber-information at least to be exposed to at least one further subscriber, with said mobile station comprising a transmitter for transmitting an update code to said network via at least one fixed station, and with said network comprising a receiver for receiving said update code for updating at least a part of said subscriber-information stored in said database.” (col. 1, lines 41-50)

“Therefore, the invention also comprises a method of doing business, like a method for exposing subscriber-information related to a first subscriber to a second subscriber and/or a method for contacting compatible parties, etc.” (col. 4, lines 31-35)

It would have been obvious to one of ordinary skill in the art at the time of invention to include with the communication system of Suzuki the ability to change communication ID information as taught by Marcè et al. since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same functions as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Art Unit: 3693

Change location

The combined references teach a first and second user with first and second communication devices having first and second device Id's. They do not disclose changing the location of a portable communication device so the device may or may not be co-located with a credit transaction.

Obradovich et al. discloses a personal communication device (PCD) that allows for changing the location of the communication device. Obradovich et al. teaches a personal communication device (PCD) where:

"The PCD is a cellular-phone-sized electronic device, combining the capabilities of a GPS receiver, transceiver, digital beeper, cell phone and projection system into one compact unit." (col. 2, lines 64-67)

"By way of example, the invention can provide a requester with dynamic location information, or other data to a location anywhere in the U.S. This location information may be used to locate individuals in determining whether to authorize credit requests, whether PCD or item containing a PCD, such as an automobile, is moved, or in routing electronic communications." (col. 4, lines 64-67 and col 5, lines 1-3)

"The PCD also serves as a position monitoring device. To begin the position monitoring function the user selects the monitor on the PCD. Upon selecting the monitor function, the PCD displays a menu including INTERROG, AUTO-TIMED, and MOVE options. When the INTERROG function is selected the PCD will display an e-mail entry field allowing input by the user of an e-mail address. After the e-mail address is entered, the PCD responds to appropriate interrogatories by transmitting its current position. An appropriate interrogatory includes the security code active when the INTERROG mode was selected and an Internet e-mail address. Upon receipt of an appropriate interrogatory the PCD will transmit the GPS receiver determined latitude and longitude of the device to the e-mail address." (col. 24, lines 16-29)

"When a user selects the MOVE option the PCD displays a distance entry field and an e-mail address entry field. After entry of the distance field and the e-mail address field, the PCD transmits an e-mail containing the device location to the e-mail address specified in the e-mail field whenever the PCD moves a distance greater than the distance entered in the distance field. When the PCD transmits an e-mail indicating the device position, the current device position is stored and the PCD waits until the device has moved the distance specified in the distance field from the current location prior to again transmitting the PCD location to the e-mail address specified in the e-mail address field." (col. 24, lines 45-56)

"Thus, the PCD can be used to monitor the locations of individuals utilizing PCDs. For example, credit authorization agencies may make use of the location monitoring capability provided by the PCD in determining the validity of credit requests. FIG. 46 illustrates a method of credit authorization using the PCD. In step 1360 an individual makes a request for credit. This may be accomplished in a variety of manners, including "swiping" a credit card through a credit card reader at a gas station, supermarket, or a variety of other locations, or merely by providing a credit card to a retail clerk who thereafter requests credit authorization. The request for credit may be made to a credit card issuer, or may merely be a request for credit authorization by a credit reporting facility." (col. 24, lines 57-67 and col. 25, lines 1-3)

"If credit authorization according to prior art practices is appropriate, then the credit authorizer transmits an interrogatory to the individual's PCD in step 1368. In step 1370 the credit authorizer waits a predetermined time for a response from the PCD. In step 1371 the credit authorizer determines if a response from the PCD has been received. If a response from the PCD has been received, the credit authorizer determines if the PCD location is consistent with the request for credit in step 1372. This may be accomplished by determining if the PCD is at the location from which credit was requested." (col. 25, lines 9-22)

Therefore, it would have been obvious to one of ordinary skill in the art to include in the communication and credit authorization system of the combined references the ability to change the location of a communication device as taught by Obradovich et al. since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same functions as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claims 3, 10, and 16:

(claim 3) The method of claim 1, wherein the unique code may be changed by the cardholder at random.

While the combined references teach unique code, they do not teach changing the unique code.

Obradovich et al. in the business of approving credit with communication devices teaches:

"The password and security level are selected by the user, and are also later herein described in conjunction with the universal telephone number." (col. 26, lines 5-7)

Art Unit: 3693

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to consider the changing a security code as taught by the combined references, motivated by Obradovich, and that changing the code at random would enhance security.

Regarding claims 4 and 11:

(claim 4) The method of claim 1 wherein the request for authorization is received at a merchant location.

The above combined references teach authorizing a request at a merchant location.

Regarding claims 5, 12, and 17

(claim 5) The method of claim 1 further comprising validating the account.

Suzuki teaches validating account.

"The system of the present invention, as pertains to credit and debit card transactions taking place at a transaction terminal located in a credit card/debit card member store comprises: a host computer capable of communicating with said card transaction terminal and capable of carrying out transaction validation processing on the basis of information sent from said card transaction terminal; wherein said host computer is capable of accessing a database storing information for validating a credit card user; and said host computer identifies said credit card user as an authentic cardholder on the basis of information for recognizing said credit card user and identity information, when information in relating to identity of said credit card user and said information relating to said credit transaction validation are inputted from a portable communication terminal having said identity information registered therein." (col. 4, lines 15-30) Inherent in transaction validation would be account validation of a user.

Regarding claims 6, 13, and 18

(claim 6) The method of claim 1 further comprising determining whether the transaction is within a predefined credit limit.

Suzuki teaches Fig. 5 which has predefined credit limits.

Regarding claim 19:

The computer program product of claim 14 wherein the instruction substitutes a designation for the second location of the transaction with a predefined location, and wherein the predefined location is different from the second location.

The combined references teach a MOVE option with a distance field that would provide a predefined second location.

Art Unit: 3693

9. Claims 2, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined references in section (8) above in further view of Pub. No.: US 2001/0051920 to Joao et al.

Regarding claims 2, 9 and 15:

(claim 2) The method of claim 1, further comprising:
responsive to receiving an instruction from the cardholder associated with the account, approving the transaction regardless of the location of the first communication device.

While the combined references teach approving credit if the location is consistent with the device, they do not teach approving the transaction if the location is not consistent.

Joal et al., also in the business of credit authorization teaches:

"In cases when the cardholder is the party to the transaction, he or she, having the communication device with, or on, his or her person, may authorize the transaction at the point-of-sale location or from his or her remote location. The cardholder may also program and/or set the communication device to automatically authorize or disapprove or disallow transactions." ¶ [0041]

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to consider the situation where a communication device was not corresponding to a transaction location, as taught by Joal et al., and that this would deal with situations where the communication device was at a different location than the transaction.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

2002/0108062

Nakajima et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH L. BARTLEY whose telephone number is

Art Unit: 3693

(571)272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693